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09/028,187	02/23/98	MENDES	C M-95-3195-U.

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EXAMINER	
GERRITY, S	
ART UNIT	PAPER NUMBER
3721	

DATE MAILED: 11/13/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.
09/028,187

Applicant(s)
Mendes

Examiner
Stephen F. Gerrity

Group Art Unit
3721



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☒ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☒ received in Application No. (Series Code/Serial Number) as per schedule A.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: MI-5501976-3

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copies have been filed in parent Application Nos. 08/647,066; 08/681,627; 08/681,626; 08/759,723; 08/759,722; 08/759,727; and 08/763,679.
2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Brazil on 8 December 1995. It is noted, however, that applicant has not filed a certified copy of the MI-5501976-3 application as required by 35 U.S.C. 119(b).

This foreign priority document was not filed in parent application 08/884,529.

Drawings

3. Please note the attached *Notice of Draftsperson's Patent Drawing Review* (Form PTO-948) regarding the drawings filed 23 February 1998.
4. The drawings are objected to because of the presence of foreign language words, and because each figure on sheets 8-10 must be given its own separate figure number. Correction is required.

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5. Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must consist of two parts:

a) A *separate* letter to the Draftsman in accordance with MPEP § 608.02(r); and

b) A print or pen-and-ink sketch showing changes in *red ink* in accordance with MPEP § 608.02(v).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office Action, and *may not be deferred*.

Specification

6. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

7. The disclosure is objected to because of the following informalities: the specification does not include a section labeled "Brief Description of the Drawings", and because the specification is replete with numerous grammatical and idiomatic informalities. Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 15-17, the "whereby" clause is considered as making the claim vague and indefinite because of a lack of positive recitation in the claim of structure to perform the recited function, "a receptacle", "a filter", "a reservoir" and "outlet ports" all lack a positive recitation in the claim as a part of the claimed structure. Additionally, in claim 1, line 15, "the solid residue" and in line 16, "the liquid" each lacks antecedent basis.

Claims 2-4 each have the informality regarding the "whereby" clause as set forth above with regard to claim 1.

Double Patenting

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114

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USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

11. Claims 4, 5, 7 and 8 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 2 and 4 of prior U.S. Patent No. 5,720,218. This is a double patenting rejection.

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a

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nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claim 6 is rejected under the judicially created doctrine of double patenting over claim 3 of U. S. Patent No. 5,720,218 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: arrangement of radial blades on a fruit juice extraction apparatus.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

14. Claims 4-8 of this application conflict with claims 5-8 of Application No. 08/884,529. 37 CFR 1.78(b) provides that when two or more applications filed

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by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

15. Applicant is advised that should claim 7 be found allowable, claim 8 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 7 and 8 are exact duplicates of one another.

Allowable Subject Matter

16. Claims 1-3 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references made of record are cited to show juice extracting machines of interest. Copies of the references made of record

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on the attached form (PTO-892) for which copies are not provided with this Office action may be found in one or more of the parent applications.

18. Any inquiry concerning this communication should be directed to Examiner Stephen Gerrity whose telephone number is (703) 308-1279.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 3720 receptionist whose telephone number is (703) 308-1148.


Stephen F. Gerrity
Primary Examiner
Group 3720
Art Unit 3721